

REMARKS

Status of the Claims.

Claims 1, 3-5, 7-19, and 22-32 are pending with entry of this amendment, claims 2, 6, 20, and 21 being cancelled and no claims being added. Claims 1 and 17 are amended herein. Support for this amendment is found at page 4 lines 29-32.

Priority claim.

The Examiner objected to the previously presented priority claim alleging that it introduced new matter, and that a petition for unintentionally delayed benefit claim under 37 CFR 1.78(a)(3) is required to effect the priority claim.

Contrary to the Examiner's assertion, in the present case, no Petition is required to change the priority claim. As stated in 37 CFR §178(a)(2)(ii):

... These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. **The time periods in this paragraph do not apply if the later-filed application is:**

- (A) An application for a design patent;
- (B) **An application filed under 35 U.S.C. 111(a) before November 29, 2000; or ...**

The present application was filed on March 19, 1999, and is thus an application filed under 35 U.S.C. 111(a) before November 29, 2000. Accordingly the only requirement to correct the priority claim is to properly amend the specification and to provide a substitute Application Data Sheet (ADS).

The priority claim is amended herein to recite:

This application is a continuation-in-part of USSN 08/904,871, now issued as US Patent 6,046,014, filed on August 1, 1997, which claims priority to and benefit of USSN 60/023,217, filed on Aug. 2, 1996, both of which are incorporated herein by reference for all purposes.

The priority claim thus properly identifies the relationship between the various applications. Moreover, the incorporation by reference of the priority documents was made in the

application as originally filed. Accordingly, the priority claim is properly made and the "new matter rejection " and objection to the specification on these grounds should be withdrawn.

35 U.S.C. §102.

WO 98/05944.

Claims 1, 3, 7, 9-19, 22, 25, and 27-32 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by WO 98/05944. Applicants traverse.

The present application claims priority to USSN 08/904,871 (US 6,046,014), filed on August 1, 1997, and to USSN 60/023,217, filed on Aug. 2, 1996. The WO 98/05944 is the international filing corresponding to 08/904,871 and the specifications are essentially identical. Thus, to the extent WO 98/05944 allegedly anticipates the presently pending claims, support for those claims is found at least in the August 1, 1997 priority document.

WO 98/05944 is thus not prior art under 35 U.S.C. §102(b) and the rejections on these grounds should be withdrawn.

EMBL Data Library March 1995

Claim 1 was rejected under 35 U.S.C. §102(b) as allegedly anticipated by Marshall and Neale submitted to the EMBL Data Library March 1995. Applicants traverse.

Claim 1 as amended herein recites:

1. A composition comprising:
an apophytochrome polypeptide consisting of less than-about 400 amino acids, which apophytochrome polypeptide comprises a lyase domain having lyase activity, wherein said apophytochrome polypeptide is selected from the group consisting of a plant apophytochrome polypeptide, an algal apophytochrome polypeptide, and a cyanobacterial apophytochrome polypeptide; and
a bilin, wherein the polypeptide is covalently linked to said bilin to form a fluorescent adduct.

The EMBL listing simply provides the amino acid sequence of an apophytochrome fragment from Douglas fir and predicts a phytochromobilin binding site at residue 244.

This reference, however, does not teach or otherwise disclose the formation of a bilin-linked phytochrome that forms a **fluorescent adduct** as recited in the presently pending claim 1. In addition, this reference fails to teach that the disclosed fragment comprises a lyase domain having lyase activity. Accordingly the EMBL reference fails to anticipate the presently claimed invention and the rejection of claim 1 under 35 U.S.C. §102(b) on these grounds should be withdrawn.

In view of the foregoing, Applicants believes all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Should the Examiner seek to maintain the rejections, Applicants request a telephone interview with the Examiner and the Examiner's supervisor.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 267-4161.

BEYER WEAVER, LLP
500 12TH STREET, SUITE 200
OAKLAND, CA 94607
TEL: (510) 663-1100
FAX: (510) 663-0920

Respectfully submitted,

/Tom Hunter/

Tom Hunter
Reg. No: 38,498